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10/091,303	03.06.2002	Naoya Yasuda	50083 217	8165

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EXAMINER

THAI, LUAN C

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

10/091,303

### Applicant(s)

YASUDA, NAOYA

### Examiner

Luan Thai

### Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 3,4 and 6-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with *traverse* of Embodiment 5 of Figures 4A-4B on which claims 1, 2, 5 and 6, are readable, in Paper No. 5, is acknowledged. The traversal is on the ground(s) that Figs. 1A-1B and Figs. 1C-1D show different states of a single embodiment. This is not found persuasive because Figs. 1A-1B disclose a mold for forming a package having a large thickness of the sealed resin 15, and Figures 1C-1D discloses a mold for forming a package having a smaller thickness of the sealed resin 15', as previous mentioned on Election/Restriction paper No. 4, dated 01/17/03. In addition, claim 6 recites "a plurality of kinds of external-shape regulating members being provided and selectively accommodated in the main cavity" that is directed to the non-elected Embodiment 9 of Fig. 9; therefore, not only claims 3-4, 7-14 but also claim 6 are withdrawn from consideration as being directed to non-elected Embodiments. The Examiner, however, agrees with the Applicant that Claim 1 is generic to the Embodiment 1-5 and 7-9.

Since the restriction for examination purposes as indicated is proper, the requirement is still deemed proper and is therefore made FINAL.

### *Priority*

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

***Information Disclosure Statement***

3. The information disclosure statement (IDS) filed on 08/19/02 has been considered by the examiner.

***Oath/Declaration***

4. The declaration filed 03/06/02 is acceptable.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Utsumi et al (6,081,978).

The figures and reference numbers referred to in this office action are used merely to indicate an example of a specific teaching and are not to be taken as limiting.

Regarding claims 1 and 2, Utsumi et al (see specifically figures 1a-1b-1c) disclose a resin sealing apparatus comprising: a mold (31) having a main cavity (31c) in which a portion of a semiconductor device (12) to be sealed with a resin (14) (see figure 2) is disposed; an external-shape regulating member (32A, 32B, or 32C, in Figs. 1a, 1b, or 1c, respectively) detachably accommodated in the

main cavity of the mold, for forming a new cavity within the main cavity, wherein a surface of the external-shape regulating member that faces an inner-wall surface of the main cavity is formed along the inner-wall surface of the main cavity.


Regarding claim 5, Utsumi et al. further disclose a close-contact holding unit, which is the end portion of the element 34A connected to the external-shape regulating member (32A, 32B, or 32C) for holding the external-shape regulating member accommodated in the main cavity of the mold on the inner-wall surface of the main cavity in close contact with this surface (Col. 8, lines 59+).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan Thai whose telephone number is (703) 308-1211. The examiner can normally be reached on 7:00 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David L. Talbott can be reached on (703) 305-9883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Luan Thai  
May 14, 2003

  
DAVID L. TALBOTT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 200